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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application Number: 10/766,482

Art Unit: 3723

Applicants: Donald Robert BOSTEN, et al.

Examiner: Robert ROSE

Filed: January 29, 2004

Confirmation No. 3724

Title: IN-LINE SANDER

Attorney Docket No.: 54525.000096

**MAIL STOP PETITION**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181(a)**

Sir,

A Notice of Abandonment was mailed December 9, 2005, in the above referenced patent application. Applicants respectfully submit that the application was not abandoned and request that the holding of abandonment be withdrawn. The following explains the relevant history of the application.

On July 13, 2005, a Notice of Non-Compliant Amendment was mailed. The Notice of Non-Compliant Amendment was followed with the Notice of Abandonment on December 9, 2005. The Notice of Non-Compliant Amendment indicated that a prior Applicants' response, April 29, 2005, was non-compliant. The Notice of Non-Compliant Amendment set forth a shortened period for reply of one month. However, the Notice of Non-Compliant Amendment also indicated that the response appeared to be a "*bona fide* attempt to reply" and explicitly stated that extensions of time under 37 C.F.R. § 1.136(a) were available. Notice of Non-Compliant Amendment, p. 2-3. This statement by the Examiner comports with 37 C.F.R. § 1.135 which states that, "When reply by the applicant is a *bona fide* attempt to advance the application to final action, . . . applicant may be given a new time period for reply under § 1.134 to supply the omission."

Under 37 C.F.R. § 1.136(a), the deadline for a reply to the Notice of Non-Compliant Amendment can properly be extended up to **January 13, 2006** when accompanied by a petition for an extension of time and the appropriate fee. A Petition for Five-Month Extension of Period for Reply and the appropriate fee are herewith submitted.

Additionally, MPEP § 714.03 states:

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, *may file a continuing application during this period* (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

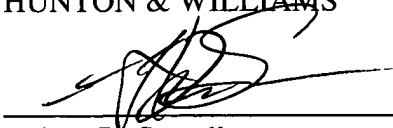
(emphasis added). Accordingly, a continuing application claiming priority to the above referenced application is submitted on January 13, 2006 in conjunction with this petition.

In view of the facts as discussed above, Applicants respectfully submit that the above referenced application was not abandoned and request that the holding of abandonment be withdrawn. A copy of the Notice of Non-Compliant Amendment and the Notice of Abandonment are attached.

Respectfully submitted,  
HUNTON & WILLIAMS

Dated: 13 Jan 2006

By:

  
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For: Christopher C. Campbell  
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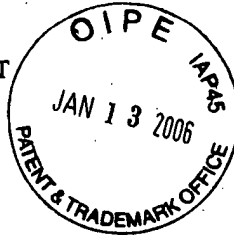
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,482	01/29/2004	Donald Robert Bosten	54525.000096	3724

21967 7590 07/13/2005

HUNTON & WILLIAMS LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109



EXAMINER

ROSE, ROBERT A

ART UNIT PAPER NUMBER

3723

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED	7-14-05
ACTION CODE	Non-Compliant Draft
DUE DATE	8-13-05
BASE DATE	7-13-05
DEADLINE	1-13-06
ATTORNEYS	CCC
INITIALS	Ap

54525.96  
RECEIVED

JUL 14 2005

HUNTON & WILLIAMS LLP  
3782

# Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.

10/766,482

Examiner

Robert Rose

Applicant(s)

BOSTEN ET AL.

Art Unit

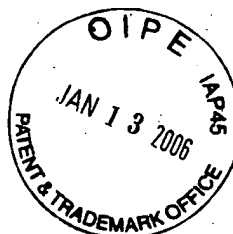
3723

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

The amendment document filed on 29 April 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
  - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
  - ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See Continuation Sheet.



For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflver.pdf>.

## TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Continuation of 4(e) Other: Cancellation of all pending claims and submission of claims directed to a different invention renders the amendment non-compliant. (See attached action).

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### DETAILED ACTION

Newly submitted claims 21-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1-20, were drawn to an in-line sander, classified in class 451, subclass 356.

Claims 28-39, are drawn to a tool kit and method of sanding, classified in class 451, subclass 28.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed is performed with a kit comprising several sanding pads, the kit being patentably distinct from the in-line sander as previously claimed. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

2. The amendment filed on April 29, 2005 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention.

3. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS,



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whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

4. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (571) 272-4494.

Robert Rose  
Primary Examiner  
Art Unit 3723



Rr

July 6, 2005.



# UNITED STATES PATENT AND TRADEMARK OFFICE

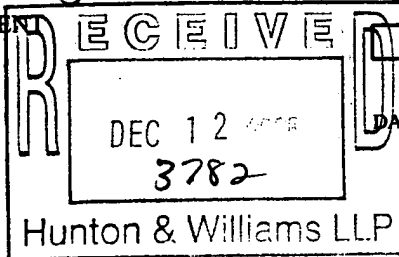
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21967 7590 12/09/2005

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SUITE 1200  
WASHINGTON, DC 20006-1109



EXAMINER

ROSE, ROBERT A

ART UNIT PAPER NUMBER

3723

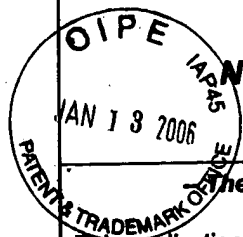
DATE MAILED: 12/09/2005



\* 12/12/05

Please find below and/or attached an Office communication concerning this application or proceeding.





# Notice of Abandonment

Application No.

10/766,482

Examiner

Robert Rose

Applicant(s)

BOSTEN ET AL.

Art Unit

3723

The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 29 October 2004.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☒ A reply was received on 29 April 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Applicant's amendment was held non-responsive in a letter mailed 7/13/05. No further action by Applicant was taken, and the period for response has expired.

Robert Rose  
Primary Examiner  
Art Unit: 3723

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.